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 Response to Final Office Action dated October 19, 2004

REMARKS

No claims have been amended, no claims have been canceled, and no new claims have been added. Claims 1-25 are therefore pending.

Double Patenting

The Final Office Action objects to Claim 8 as being a substantial duplicate of claim 1 under 37 CFR 1.75. As this is a prospective objection that will not mature unless and until claims 1 and 8 are allowed in their present form, this objection will be addressed substantively only should claims 1 and 8 be allowed in their present form.

Claim Rejections - 35 USC § 102

A. Introduction

The Final Office Action maintains the earlier rejection of claims 1-4, 7-18, 21, 24 and 25 under 35 USC § 102(e) as anticipated by Angles (US 5, 933,811). This rejection is respectfully traversed. MPEP § 706.02 (p. 700-21) states that under 35 USC § 102, a prior art "reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present." The Final Office Action asserts that the limitations recited in the claims are taught by Angles. However, as set forth and herein and in the Response filed July 30, 2004, the cited reference fails to teach either explicitly or impliedly every aspect of the invention recited in the claims. Therefore, each of the claims 1-4, 7-18, 21, 24 and 25 is patentably distinct from and is patentable over the cited reference.

We request that the Examiner reconsider the cited art in view of the claims and either allow the claims or present additional arguments in view of the July 30, 2004 Response and the below arguments.

B. Claim 1

In the July 30, 2004 Response, we requested that the Examiner explain which element of Angles the Examiner asserts teaches the sponsorship data recited in claim 1. We thank the Examiner for responding to this request for further explanation. In the Final Office Action, the Examiner

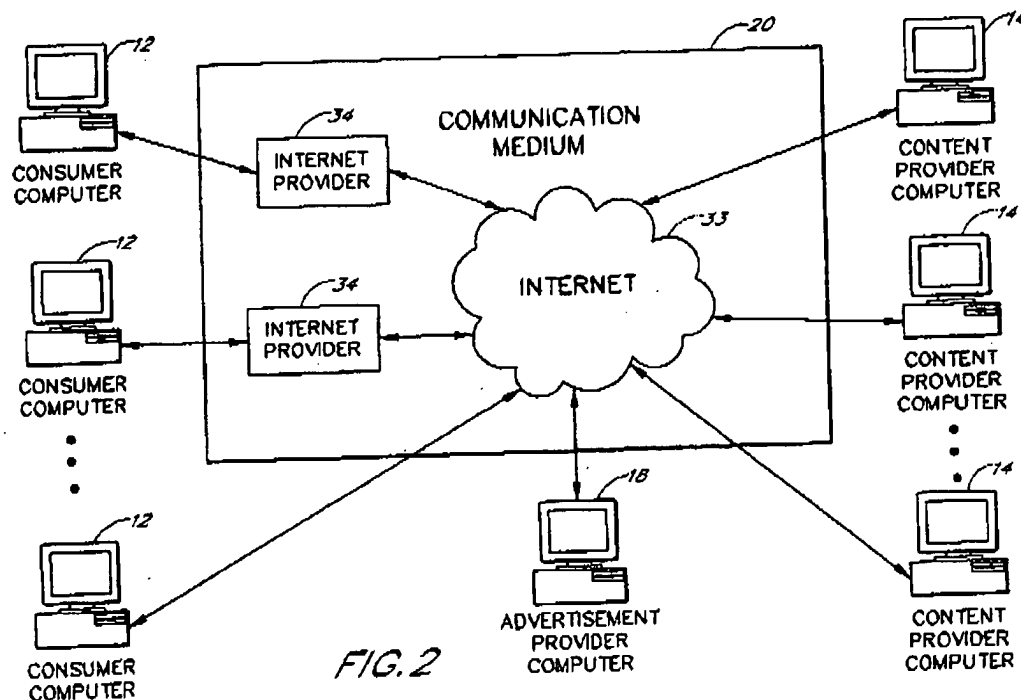
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responds that "Angeles discloses the client's browser receiving a requested webpage which includes a targeted advertisement (sponsorship object) which includes a hyperlink (sponsorship label with click-through) that the user may select to retrieve additional information (another advertisement) about the product or sponsor from another website (the URL associated with the hyperlink is the resource locator). However, regardless of this explanation, the cited portion of Angeles teaches a system and functionality wholly different from that recited in claim 1.

As one picture is worth one thousand words, please refer to Fig. 2 of Angeles.



The system taught by Angeles describes how an advertisement provider 18 integrates advertisements in web pages provided by content providers 14 to web browser users at consumer computers 12 based on consumer profiles maintained by the advertisement provider 18. The transmission of the advertisements to the consumer computer 12 by the advertisement provider 18 is triggered by an embedded advertisement request included in a user requested web page transmitted to the consumer computer 12 by the content provider 14. (Angeles, col. 8, line 45 - col. 8, line 19) In

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contrast to Angles, Claim 1 is directed toward the interaction between a client application (not in Angles) on a consumer computer (Angles consumer computer 12) and an online server (Angles internet provider 34) associated with an online service. As such, Angles fails to teach the client application, the online server and the online service performing the method recited in claim 1.

In Angles, the consumer computer 12 may obtain access to the Internet 33 via internet provider 34. However, the teachings of Angles are focused on the interaction of the advertisement provider 18 and the content provider 14 with each other and with the consumer computer 12. No substantive teachings or any portion of the invention described in Angles involve the Internet provider 34. (See Angles col. 9, lines 35 – 64) Moreover, Angles fails to teach a client application as recited in the claims and is instead focused on the consumer browser module 40, a web browser. (Angles, Figs. 4 and 11; col. 8, line 45 - col. 8, line 19; col. 10, lines 43-59)

A second picture is worth another thousand words. The following is Fig. 3 from Angles.

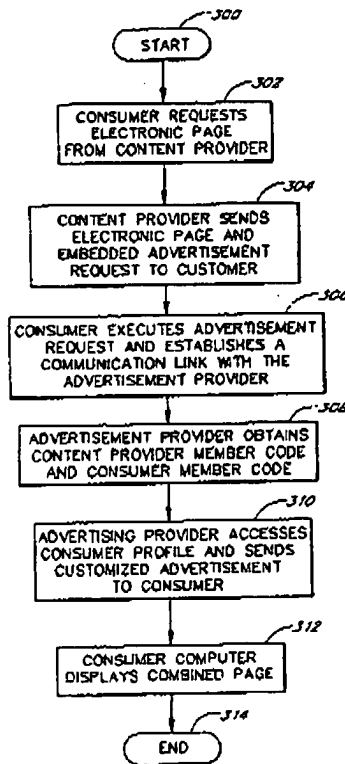


FIG. 3

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As set forth in Fig. 3, after a consumer requests an electronic page from a content provider (302), the content provider sends an electronic page (web page) and an embedded advertisement request to the consumer (304). The consumer executes the advertisement request and establishes a communication link with the advertisement provider (306). The advertisement provider eventually sends a customized advertisement to the consumer based on a consumer profile (310). The combined advertisement and web page are displayed for the consumer (312). As set forth in Fig. 3, the method taught by Angles appears to be a way of providing customized ads, such as, for example, banner ads, to users who request a particular web page. As such, the teachings of Angles are wholly different from and do not teach the limitations recited in claim 1.

Claim 1 recites, generally, "a method of displaying advertisements to a user of an online service using a client application on a local device," "the local device accessing an online server associated with the online service and providing interaction with the online service." The method includes "the client application commencing an online session with the online server," "the online server transmitting sponsorship data to the client application, the sponsorship data comprising a sponsorship object including a resource locator associated with a sponsorship label to be displayed and a resource locator associated with a click-through of the sponsorship label." "The client application causing a client window to be displayed on the output device," "displaying a sponsorship label on the client window," and "causing a first advertisement to be displayed in the client window."

"The sponsorship label comprising a hypertext link, wherein, when the user clicks through on the sponsorship label, the client application causes the local device to access the resource locator associated with a click-through of the sponsorship label."

In contrast to the teaching of Angles, the claims do not recite in any way an advertisement request provided in combination with a web page to a user's web browser. Rather, the sponsorship data ("the sponsorship data comprising a sponsorship object including a resource locator associated with a sponsorship label to be displayed and a resource locator associated with a click-through of the sponsorship label) is transmitted by the online server to the client application. Unlike both the advertisement and the advertisement request of Angles, the sponsorship data is not included in a web

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page in a web browser; rather, the sponsorship label of the sponsorship data is displayed on the client window. (See Specification, element 722 and Fig. 8)

It is abundantly clear that the software entities differ between Angles and what is recited in claim 1. It is abundantly clear that the information, files, data, etc. transmitted between the software entities differ between Angles and what is recited in claim 1. Further, the end result of what is recited in claim 1 differs from what is taught in Angles – that is, in Angles, the end result is a web browser displaying a web page that includes an advertisement integrated within it, whereas, in contrast, the end result of claim 1 is an advertisement displayed in the client window of the client application. Moreover, in Angles, the “combined” web page includes content from a content provider and an ad from the ad provider. (Angles, Fig. 3)

What follows is a table showing how the elements of Angles cited by the Examiner differ from and do not teach or suggest what is recited in claim 1.

<i>Claim term</i>	<i>Examiner's Citation to Angles</i>	<i>Differences</i>
client application	web browser	A set forth in the specification, a client application and a browser have different capabilities and perform different functions. (Specification, p. 15, line 14 – p. 16, line 2; p. 16, lines 8-9; p. 16, lines 15-18; p. 17, line 17 - p. 18, line 5) The functionality of a browser is also made clear in Angles. (Angles, col. 9, lines 43-59)
online server associated with the online service	content provider (web server in the Specification)	An online server and a content provider (web server) have different capabilities and perform different functions. (Specification, p. 15, lines 3-8; p. 16, line 15 – p. 17, line 4; p. 17, line 16 - p. 18, line 5) This distinction is made clear in Angles (col. 9, lines 35-54; col. 10, lines 8-18)

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<i>Claim term</i>	<i>Examiner's Citation to Angeles</i>	<i>Differences</i>
the client application causing a client window to be displayed	combined web page having content from a content provider and an ad from an ad provider displayed in a web browser	A client window is displayed by the client application and includes information provided by the online server, namely the first advertisement and the sponsorship label, whereas in Angeles a web page provided by a user specified content provider having an integrated advertisement provided by an advertisement provider is displayed in a web browser. (Specification, p. 18, lines 13-16; Angeles, col. 8, lines 33-67)
sponsorship data that includes a sponsorship object and a sponsorship label transmitted by the online server to the client application	the content provider obtaining an advertisement from the advertisement provider and integrating the advertisement in a user requested web page, the content provider transmitting the web page to a user's web browser	All of the participants in the method, the flow of information, and the content of the information transmitted among the participants are wholly different between the claimed system and the Angeles system.

We invite the Examiner to call us to discuss the content of this table and the arguments set forth herein.

So as not to be redundant, we hereby incorporate by reference all of the arguments contained in the July 30, 2004 Response.

C. Request to Reissue of Office Action

With regard to claim 21, the July 22, 2004 Office Action failed to address limitations g), h), i) and j). In the July 30, 2004 Response we requested that the Examiner provide recitation to specific portions of Angeles that the Examiner asserts recite limitations g), h), i) and j) of claim 21. We thank the Examiner for providing this requested information in the Final Office Action. However, as the

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July 22 Office Action was deficient in not sufficiently supporting the rejections provided, we assert that issuing a Final Office at this point in prosecution is improper. That is, because the July 22, 2004 Office Action did not meet the requirements of the Patent Office, the curative, next Office Action can not properly be a Final Office Action. We hereby request that the Final Office be reissued as a regular Office Action.

D. Other Claims

To the extent claims 7, 11, 15 and 21 have limitations similar to those discussed above with regard to claim 1, the above arguments also apply to claims 7, 11, 15 and 21. As claims 8 and 12 depend on claims 7 and 11, claims 8 and 12 are patentable over Angles by virtue of their dependency on claims 7 and 11.

E. Claim 21

In addition, with regard to claim 21, in the Final Office Action the Examiner states that the functionality of the advertising module 62 of the advertisement provider 18 of Angles teaches certain functionality of the claimed client application. (Final Office Action, p. 9, para. C) However, an advertising module located on a advertisement provider (as shown in Fig. 4 of Angles) cannot and does not teach the functionality of a client application running on a client/user computer. This is primarily because the functionality of a server cannot be used to teach the functionality of a client. (See Angles, col. 5, lines 62-66)

F. Summary

For all of the reasons asset forth above, Angles fails to teach each and everyone of the limitations recited in claims 1, 7, 8, 11, 12, 15 and 21. As such, these claims, and all claims dependent thereon are patentable over Angles.

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Claim Rejections - 35 USC § 103

The Office Action rejects claims 5, 19, 22, 23 and under 35 USC § 103(a) unpatentable over Angles. This rejection is respectfully traversed.

Claims 5, 19, 22, 23 are ultimately dependent on claims 1, 15 and 21. Claims 1, 15 and 21 are discussed above regarding the 35 USC § 102 rejections. For the same reasons claims 1, 15 and 21 are patentable over Angles as set forth above and in the July 30, 2004 Response, by virtue of their dependency on these claims, claims 5, 19, 22, 23 are not rendered obvious by and are patentable over Angles.

The Office Action rejects claims 6 and 20 under as being unpatentable over Angles and Filepp (US 5,347,632) This rejection is respectfully traversed.

Claims 6 and 20 are ultimately dependent on claims 1 and 15. Claims 1 and 15 are discussed above regarding the 35 USC § 102 rejections. For the same reasons claims 1 and 15 are patentable over Angles as set forth above, by virtue of their dependency on these claims, claims 6 and 20 are not rendered obvious by and are patentable over Angles. Filepp fails to cure the deficiencies of claims 1 and 15 discussed above.

So as not to be redundant, we hereby incorporate the 35 USC § 103(a) arguments presented in the July 30, 2004 Response.

The combination of Angles and Filepp fails to teach or suggest the limitations recited in claims 6 and 20. As such, claims 6 and 20 are not rendered obvious by and are patentable over the combination of Angles and Filepp.

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Conclusion

In view of all of the above, it is respectfully submitted that the present application is now in condition for allowance. Reconsideration and reexamination are respectfully requested and allowance at an early date is solicited.

The Examiner is invited to call the undersigned attorney to answer any questions and to discuss steps necessary for moving prosecution of this matter forward.

Respectfully submitted,



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